

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

MAR 25 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LORONZO H. THOMSON,
BRIAN THOMSON and MARK P. McJUNKIN

Application No. 09/658,389

ORDER RETURNING TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on March 8, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

An examination of the record indicates that in the Final Rejection mailed May 1, 2003 (Paper No. 20), the following rejections were made:

1. Claims 8, 9, 19, 28, and 33-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification . . . ;

2. Claims 1-3, 10, 12, 13, 15, 17, and 20-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 09/658,509 in view of Cheng, U.S. patent 5,477,747;

3. Claims 1-3, 10, 12, 13, 17, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheng;

4. Claims 4-6, 18, 24-27, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng in view of Roddy, U.S. Patent 5,881,606; and

5. Claims 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng in view of Lai, U.S. Patent 5,509,328.

In the Examiner's Answer mailed November 13, 2003 Paper No. 23), the examiner notes that rejections 1-3 above "[are] set forth in prior Office Action, Paper No. 20." However, the examiner listed the 103(a) rejection as follows:

Claims 4-6, 15, 18, 22, 24-27, and 29-31 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 20.

Clarification is required regarding the status of the Lai reference (U.S. Patent 5,509,328) discussed on pages 7 and 8 of the Final Rejection.

In addition, the Appeal Brief filed October 6, 2003 (Paper No. 22) does not comply with section 1206(9) of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 1, Feb. 2003), which states:

The copy of the claims required in the brief Appendix by 37 CFR 1.192(c)(9) should be a clean copy and should not include any brackets or underlining.

Accordingly, it is

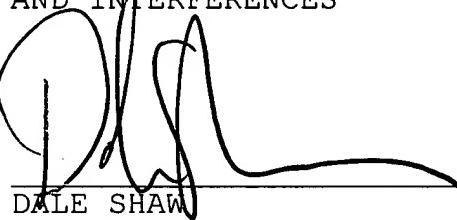
ORDERED that the application is returned to the Examiner:

1. for clarification regarding the status of the Lai reference (U.S. Patent 5,509,328);
2. If appropriate, for compliance with MPEP § 1208(A)(9) by listing the Lai reference under the heading "References of Record" in a Supplemental Examiner's Answer;
3. for notification to appellants to submit a new Appendix to the Appeal Brief filed on October 6, 2003 (Paper No. 22), or for the examiner to issue a Supplemental Examiner's Answer which contains a correct copy of claim 28, and for such further action as may be appropriate.

4. for written notification to appellants regarding the action taken; and
5. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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